



**Sterne Kessler  
Goldstein Fox**

ATTORNEYS AT LAW



112, 2nd - 9-

Robert Greene Sterne  
Edward J. Kessler  
Jorge A. Goldstein  
David K.S. Cornwell  
Robert W. Esmond  
Tracy-Gene G. Durkin  
Michele A. Cimbalà  
Michael B. Ray  
Robert E. Sokohl  
Eric K. Steffe  
Michael Q. Lee  
Steven R. Ludwig  
John M. Covert  
Linda E. Alcorn  
Robert C. Millonig  
Lawrence B. Bugalsky  
Donald J. Featherstone  
Michael V. Messinger  
Judith U. Kim  
Timothy J. Shea, Jr.

Patrick E. Garrett  
Jeffery T. Helvey\*  
Heidi L. Kraus  
Crystal D. Sayles  
Edward W. Yee  
Albert L. Ferro\*  
Donald R. Banowit  
Peter A. Jackman  
Molly A. McCall  
Teresa U. Medler  
Jeffrey S. Weaver  
Kendrick P. Patterson  
Vincent L. Capuano  
Albert J. Fasulo II\*  
Eldora Ellison Floyd  
W. Russell Swindell  
Thomas C. Fiala  
Brian J. Del Buono\*  
Virgil Lee Beaton\*  
Reginald D. Lucas\*

Kimberly N. Reddick  
Theodore A. Wood  
Elizabeth J. Haanes  
Bruce E. Chalker  
Joseph S. Ostroff  
Frank R. Cottingham\*  
Christine M. Uhler  
Rae Lynn Prengaman\*  
Jane Shershenovich\*  
Lawrence J. Carroll\*  
George S. Bardmesser

Senior Counsel  
Samuel L. Fox  
Kenneth C. Bass III

Registered Patent Agents  
Karen R. Markowicz  
Andrea J. Kamage

Nancy J. Leith  
Joseph M. Conrad III  
Ann E. Summerfield  
Helene C. Carlson  
Gaby L. Longworth  
Matthew J. Dowd  
Aaron L. Schwartz  
Angelique G. Uy  
Boris A. Matvenko  
Mary B. Tung  
Katrina Y. Pei  
Bryan L. Skelton  
Jason D. Eisenberg

\*Admitted only in Maryland  
\*Admitted only in Virginia  
\*Admitted only in Texas

May 20, 2002

WRITER'S DIRECT NUMBER:  
(202) 371-2560

INTERNET ADDRESS:  
RESMOND@SKGF.COM

Commissioner for Patents  
Washington, D.C. 20231

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MAY 22 2002

Art Unit 1651

TECH CENTER 1600/2900

Re: U.S. Utility Patent Application  
Appl. No. 09/028,514; Filed: February 23, 1998  
For: **Serum-Free Mammalian Cell Culture Medium, and Uses Thereof**  
Inventors: Gorfien, *et al.*  
Our Ref: 0942.4110002/RWE/B-C

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

1-14  
1599-1580  
15-37  
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1-3  
6-17  
20-24  
27-37  
73-77  
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154  
157-174

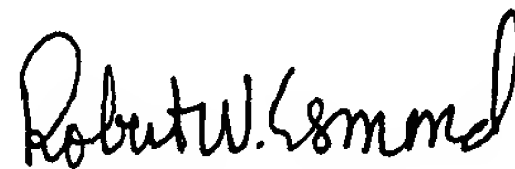
1-3, 6-17, 20-24, 27-37,  
73-82, 106-108, 112, 140

Commissioner for Patents  
May 20, 2002  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond  
Attorney for Applicants  
Registration No. 32,893

RWE/B-C:law  
Enclosures

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JMS  
5/22/02

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gorfien, *et al.*

Appl. No. 09/028,514

Filed: February 23, 1998

For: **Serum-Free Mammalian Cell  
Culture Medium, and Uses Thereof**

Confirmation No. 4800

Art Unit: 1651

Examiner: Ware, Deborah K.

Atty. Docket: 0942.4110002/RWE/B-C

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TECH CENTER 1600/2900

**Reply To Restriction Requirement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **April 23, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 1-3, 6-17, 20-24, 27-37, 73-77, 140, 154, and 157-174. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

Applicants wish to clarify a point prior to presenting their reasons for traversal. The mammalian cells in the methods of independent claims 1, 15, 22, 157, 158, and 161 may be either recombinant or non-recombinant. Applicants also wish to point out that independent claim 106 also encompasses cultivating both a recombinant and a non-recombinant mammalian cell. Thus, the methods of Group I are not limited to non-recombinant cells and the methods of Group II are not limited to recombinant cells.

The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants respectfully assert that the claims in Groups I and II are closely related in subject matter. In fact, a search for methods of cultivating mammalian cells—claims 1, 15, 22, 158 and claims dependent thereon—must *necessarily* encompass a search for methods of cultivation of mammalian cells that are genetically engineered and used for protein expression—see, for example, claims 79, 106 and claims dependent thereon—because, as discussed above, the invention of Group I is not limited to non-recombinant cells. Applicants note that claim 79 depends from claims 1, 5, and 22 and a search for the inventions of these claims must encompass the invention of claim 79.

Moreover, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.* the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Applicants respectfully submit that a search of Group I is likely to encompass subject matter pertinent to the patentability Group II and, therefore, searching both Groups does not represent a serious burden on the Examiner. Hence, reconsideration and withdrawal of the

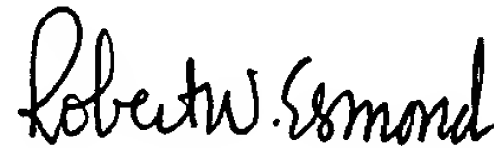
Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Should the Examiner maintain the Restriction Requirement and search only Group I, Applicants respectfully request that the Examiner consider rejoinder of Group II if the search performed encompasses the inventions of the restricted claims.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond  
Attorney for Applicants  
Registration No. 32,893

Date: May 20, 2002

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600